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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,365	07/12/2007	Harry Kany	JD-337-US	8880
24804 7550 05/18/2011 Diversy, Inc. 8310 16TH STREET, M/S 509 PO BOX 902 STURTEVANT, WI 53177-0902			EXAMINER BOYER, CHARLES I	
			ART UNIT 1761	PAPER NUMBER
			MAIL DATE 05/18/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/593,365

Applicant(s)

KANY ET AL.

Examiner

Charles I. Boyer

Art Unit

1761

Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-37, 40 and 43-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-47 is/are allowed.
- 6) ☒ Claim(s) 21-37, 40, 43, 44 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to applicants' request for continued examination received April 26, 2011. Claims 21-37, 40, and 43-48 are currently pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21-30, 32-37, 43, 44, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto et al, US 5,372,743.

Miyamoto et al teach a degreasing bath for steel metal surfaces comprising an ethoxylated mono/di-ester phosphate and a mixture of alkali builders (col. 10, table 3) which is added to water to form a degreasing composition. With respect to claim 29, ethoxylated phosphate esters are well-known defoamers. As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-29, 31, 33-37, 40, 43, 44, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aubert et al, US 5,858,928.

Aubert et al teach an industrial cleaning agent for hard surfaces (col. 1, lines 10-12) comprising amino methyl propanol, ethoxylated phosphate diester, additional nonionic surfactant, and water (col. 9, example 1). With respect to specific chelants, surfactants, and alkanolamines claimed, as these components are optional and therefore may be absent, they do not further limit the claim. While the reference does not make specific mention of metals, it is well known to persons of ordinary skill and consumers alike, that hard surface cleaners are formulated to include the cleaning of metals.

Applicants have traversed this rejection on the grounds that a hard surface cleaner doesn't necessarily mean a metal cleaner. While the examiner concedes the point, metals are common household surfaces that are encompassed by any hard surface cleaner, and so any hard surface cleaner's use on metals is patently obvious. Applicants further argue this reference's mere mention of a possible use of the disclosed compositions "as agents for the industrial cleaning of hard surfaces" provides an insufficient basis from which to conclude that it would be obvious to modify the compositions to optimize the selection of the phosphate diester compound to achieve the claimed result and then apply the compositions to metal surfaces under the claimed conditions (emphasis added). First, the examiner maintains a specific teaching of using the composition as a

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hard surface cleaner provides ample motivation to a person of skill in the art. Furthermore, despite applicants' assertion, there is no "modification" of the composition necessary. The composition of the reference is identical to the composition claimed.

4. Claims 21-37, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubin et al, US 4,528,039.

Rubin et al teach an alkaline aluminum cleaner comprising sodium carbonate, fatty acid soap anionic surfactant, propylene glycol, and ethoxylated phosphate ester (col. 13, example 11). Preferred phosphate esters of the invention include ethoxylated phosphate diesters (col. 7, lines 7-32). Accordingly, it would have been obvious to one of ordinary skill in the art to use a diester surfactant in example 11 with complete confidence of formulating an effective aluminum cleaner.

Applicants have traversed this rejection on the grounds that it cannot be considered obvious to modify Rubin's compositions to optimize the selection of the phosphate ester compound based on its anticorrosive properties to achieve the claimed result. The examiner maintains as the reference specifically teaches diesters as preferred phosphate esters of the invention, there is ample motivation for one of ordinary skill to incorporate a diester into example 11. It is not necessary for the reference to add the ester for the same reason as applicants. The examiner accepts applicants' argument that a composition containing a diester possesses superior anti-corrosive properties, but again, as the reference specifically teaches

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diesters as a preferred surfactant, the addition of such a surfactant is obvious for one of skill in the art.

5. Claims 21-37, 40, 43, 44, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geke et al, US 4,578,208.

Geke et al teach a metal cleaner comprising an alkanolamine mixture, sodium gluconate, phosphoric acid ester, and nonionic surfactant (col. 10, examples 33-41). Preferred phosphate esters of the invention include ethoxylated phosphate diesters (see claim 1). Accordingly, it would have been obvious to one of ordinary skill in the art to use a diester surfactant in the examples above with complete confidence of formulating an effective metal cleaner.

Applicants have traversed this rejection on the grounds that it cannot be considered obvious to modify Geke's compositions to optimize the selection of the phosphate ester compound based on its anticorrosive properties to achieve the claimed result. The examiner maintains as the reference specifically teaches diesters as preferred phosphate esters of the invention, there is ample motivation for one of ordinary skill to incorporate a diester into the above examples. It is not necessary for the reference to add the ester for the same reason as applicants. The examiner accepts applicants' argument that a composition containing a diester possesses superior anti-corrosive properties, but again, as the reference specifically teaches diesters as a preferred surfactant, the addition of such a surfactant is obvious for one of skill in the art.

6. Claims 21-37, 40, 43, 44, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melin et al, US 4,752,411.

Melin et al teach a hard surface cleaner comprising an alkyl ether phosphate, NTA, fatty acid soap, potassium carbonate, and nonionic surfactant (col. 7, example 3). Preferred phosphate esters of the invention include ethoxylated phosphate diesters (col. 3, lines 39-55). Accordingly, it would have been obvious to one of ordinary skill in the art to use a diester surfactant in example 3 with complete confidence of formulating an effective metal cleaner. While the reference does not make specific mention of metals, it is well known to persons of ordinary skill and consumers alike, that hard surface cleaners are formulated to include the cleaning of metals.

7. Claims 21-37, 40, 43, 44, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al, US 5,259,960.

Beck et al teach an alkaline aluminum cleaner comprising a sodium/potassium hydroxide blend, sodium gluconate, an ethoxylated phosphate ester, and nonionic surfactant (col. 14, example 1). Preferred phosphate esters of the invention include ethoxylated phosphate diesters (col. 8, lines 9-28). Accordingly, it would have been obvious to one of ordinary skill in the art to use a diester surfactant in example 1 with complete confidence of formulating an effective aluminum cleaner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I. Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-F 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272 1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles I Boyer
Primary Examiner
Art Unit 1761

/Charles I Boyer/
Primary Examiner, Art Unit 1761